

REPLY TO OFFICE ACTION
DATED APRIL 15, 2008

Appln. No. 10/643,424

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REMARKS

This is in reply to the Office Action dated April 15, 2008. Reconsideration is respectfully requested.

Status of Claims

Claims 1-3, 5, 8-11, 13-16, 18, 29-44 and 46-55 are pending. Applicant acknowledges, with appreciation, that Claims 9, 46, 49, 50, 52 and 53 are allowed. Claims 1-3, 5, 8-11, 13-16, 18, 37-41, 47, 48, 51, 54 and 55 are rejected as allegedly failing to comply with the written description requirement. Claim 1 is further rejected as supposedly being indefinite.

Claims 1, 5, 8, 10, 11, 15, 16, 18, 29, 30, 32, 36, 47 54 and 55 are rejected as allegedly anticipated by U.S. Patent No. 6,673,620 to Loeffler et al. Claims 1-3, 5, 8, 10, 16, 18, 29-36, 47, 54 and 55 are rejected as allegedly anticipated by U.S. Patent No. 5,192,503 to McGrath et al. Claims 1-3, 5, 18, 29-31 and 47 are rejected as allegedly anticipated by U.S. Patent No. 4,738,824 to Takeuchi. Claims 11, 13-15 and 37-44 are rejected as obvious over McGrath et al.

Claim Amendments

Applicant has amended the device claims consistent with the Examiner's indication of allowable subject matter. To that end, Claims 2, 8, 10, 11, 14, 15, 16, 18, 48, 51, 54 and 55 have been amended to depend on allowable Claim 9. These claims should be allowable as dependent on an allowable base claim. Applicant has canceled Claims 1, 3, 5, 37-44, and 47, Claims 4, 6, 7, 12, 17, 19-28 and 45 having been canceled in previous replies.

The Traversal

Applicant respectfully traverses the rejections of method Claims 29-36, contending that the cited references fail to meet the criterion necessary for anticipation. Applicant's position is explained in the arguments presented below.

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Claim 29

Claim 29 is drawn to a method for performing a step of a hybridization reaction on the surface of a substrate, and recites, in relevant part:

"removing said fluid reagent from contact with said substrate in a manner causing surface tension of said fluid in conjunction with a level of hydrophobicity or hydrophilicity of said surface of said substrate to limit formation of isolated droplets of said fluid separate from a major mass of said fluid in said housing chamber".

Claim 29 is rejected as anticipated by each of Loeffler et al, McGrath et al and Takeuchi, yet the Examiner has failed to show where in any of these references the recited removing step is taught. Applicant notes that to anticipate a claim, the reference must teach every element of the claim. "The identical invention must be shown in as complete detail as is contained in the ...claim." Richardson v. Susuki Motor Co., 9USPQ2d 1913, 1920 (Fed. Cir. 1989). For the method claims, an anticipation rejection cannot be sustained by merely stating that the apparatus of the reference is capable of carrying out the method. For anticipation, the claim element must be taught in the reference. Applicant contends that the cited references fail to teach this claim element. Only the applicant recognizes the advantage of how the fluid reagent is removed from contact with the substrate, and only the applicant's method addresses this problem.

Similarly, Claim 33 recites, in relevant part:

"removing said fluid reagent from contact with said substrate in a controlled manner at a rate that substantially eliminates formation of droplets of said fluid on said surface of said substrate".

Claim 33 is rejected as anticipated by McGrath et al. Applicant requests that the Examiner show where in McGrath et al the removing step as recited in Claim 33 is taught. Applicant contends that McGrath et al fails to teach this claim element and cannot, therefore, support a rejection on the basis of anticipation.

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Claims 30-32, 35 and 36 depend on Claim 29 and should be allowable over the cited art for the same reasons that Claim 29 is allowable. Similarly, Claim 34 depends on Claim 33 and should be allowable for the same reason that Claim 33 is allowable.

Summary

Applicant has shown, in the arguments presented above, that the cited references fail to teach every element of Claims 29-36 and, therefore, cannot support a rejection of these claims on the basis of anticipation. Applicants have also canceled or otherwise amended the claims so as to render the rejections as to indefiniteness, enablement and obviousness moot. Applicant contends that the claims as amended are allowable and requests that the rejections be withdrawn and the application passed to issue.

Respectfully submitted,

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